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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,129	11/25/2003	Hidehiko Fujiwara	040447-0255	4405
22428 7590 01/07/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER COLIN, CARL G	
			ART UNIT 2136	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/720,129

Applicant(s)

FUJIWARA ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. In communications filed on 10/16/2007, Applicant amends claims 8, 9, and 10. The following claims 1-16 are presented for examination.

1.1 In response to communications filed on 10/16/2007, the claim objection to claims 8-10 has been withdrawn in view of the amendment.

1.2 Applicant's arguments, pages 5-9, filed on 10/16/2007 have been fully considered but they are not persuasive. With regard to claim 1, Applicant argues "*Russ does not teach communications between two slave units such that one slave unit is protected by a firewall and another is not.*" In response to applicant's arguments, the recitation "a system for executing communications between a slave unit in an intranet protected by a firewall and another slave unit located outside the firewall through the Internet" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In addition, the features of firewall have been addressed with respect to claim 2, wherein Russ discloses "a DSCT which acts as a proxy for the client-receiver

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and in that case the headend transmits service instances and messages to the DSCT which then processes the service instances before re-transmitting them to the client-receiver" (see paragraph 46). and the proxy decides whether it is safe to let traffic pass through to the client-receiver (see paragraph 132) that meets the recitation of intranet with firewall (see figure 1). With respect to claim 1, Applicant adds (see arguments, page 6) "*Russ fails to teach slave units that have no mechanism for encryption. The client-receiver of Russ does have a mechanism for encryption and decryption*". Examiner respectfully disagrees. First, the paragraph cited by Applicant actually shows that the DSCT encrypts the service instance not the client-receiver (slave unit) and merely shows an embodiment for decryption using control words provided by the secure element which is different than encryption since a public-private key pair is used.

"Content that is encrypted with a public key can only be decrypted using the corresponding private key." (see paragraph 38). Therefore, applicant has not shown that the client-receiver has a mechanism to encrypt. Second, as mentioned in the rejection in paragraph 145 (which was not addressed by applicant), "Those skilled in the art will recognize that the client-receiver 122 can include more or fewer modules than described hereinabove. For example, in a non-limiting alternative embodiment, the client-receiver 122 does not include a secure element 908."

Russ clearly states the client-receiver can include fewer modules than described in paragraph 144 and for example as a non-limiting alternative embodiment, "the secure element", interpreted by

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Examiner as a mechanism for encryption is not present (one of ordinary skill in the art also understands cryptographic device can be an additional element not present). Russ also discloses the secure element generates and holds the public keys which are used for encryption (see paragraph 111), therefore, paragraph 145 clearly discloses without the module(s) (secure element and/or cryptographic device) the client-receiver does not have a mechanism to encrypt.

With respect to claims 3-4 and claims 11-13, in response to applicant about Examiner's official notice, it is noted that page 5, lines 8-11 was not cited by the Examiner. Prior art is provided for support; for instance, Smith et al 6,502,191 teaches basic concepts of firewall that includes blocking information transfer from Intranet to the Internet (see column 1, lines 34-38). It is implicit and within the knowledge of one of ordinary skill in the art that not all devices on the Internet are adapted to encryption. Use of HTTP is to allow such communications to exist with these types of devices. Smith et al further teaches a proxy server and/or delivery server (agency communication section) that executes communications without encryption or inhibits communications when an access is made from a computer in the Intranet protecting by a firewall to a receiving device (other internet server, fax machine, printer...) which is located outside the firewall and is not adapted for encryption (see column 1, lines 58-63 and column 2, lines 5-35). Therefore, applicant has not overcome the obviousness rejection of claims 3-4 and 11-13.

Regarding claims 8-10, applicant presents the same arguments as claim 1 with respect to Vassilovski therefore, claims 8-10 are maintained for the same reasons as discussed above with respect to claim 1. Upon further consideration, it remains the Examiner's position that claims 1-16 are still rejected in view of the prior art.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 5-7, and 14-16** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent US 2003/0219127 to **Russ et al.**

As per claim 1, **Russ et al** discloses a system for executing communications between a slave unit in an intranet protected by a firewall and another slave unit located outside the firewall through the Internet, the system comprises:

an agency communication section (i.e. DSCT) equipped to the intranet (see figure 1) for executing encryption or decryption by agency (see page 5, paragraph 46) for a slave unit (client-receiver 122) having no mechanism (secure element) for encryption in the intranet (see page 15, paragraph 145).

As per claim 2, **Russ et al** discloses DSCT may be acting as a proxy for the client-receiver and access control (see page 5, paragraph 46 see also paragraph 71 and fig. 3) that meets

the recitation of intranet with a firewall. **Russ et al** further discloses wherein said agency communication section (i.e. DSCT) executes the communications without encryption, when an access is made from a slave unit which is located outside the firewall and is not adapted to encryption (see page 10, paragraph 92).

As per claims 5-7, **Russ et al** discloses wherein said agency communication section has a virtual slave unit having the function of the slave unit and a function of converting voice and data formats to go beyond the firewall, and said virtual slave unit executes communications by agency (see page 4, paragraph 37 and page 12, paragraph 116).

As per claims 14-16, **Russ et al** discloses wherein a slave unit having a mechanism for encryption is used, and said slave unit has means for judging whether said slave unit is located inside or outside the firewall, said slave unit executing encryption if it is judged by said means that said slave unit is located outside the firewall or stopping the encryption function if it is judged by said means that said slave unit is located inside the firewall (see page 9-10, paragraphs 90-92).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter

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sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-4 and 11-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2003/0219127 to **Russ et al.**

As per claims 3-4, **Russ et al** substantially discloses the DSCT is adapted to determine whether communication should be encrypted or not and wherein said agency communication section executes communications without encryption or inhibits communications, when an access is made from a slave unit inside the firewall to a terminal (head end) which is located outside the firewall (see page 11, paragraph 103 and page 5, paragraph 46, sentence before last). **Russ et al** is silent about the terminal outside the firewall is not adapted to encryption, but discloses in an embodiment that encryption is not necessary for terminal inside the firewall since it is not adapted to encryption. Therefore, it would have only required routine skill in the art and design choice to have the client-receiver (i.e. laptop) communicating with a terminal not adapted to encryption (see Smith et al, US patent 6,502,191, column 1, lines 34-38; lines 58-63; and column 2, lines 5-35 for support) because **Russ et al** suggests different non-limiting factors for determining whether encryption and decryption should be carried by DSCT and this will not depart from the spirit and scope of the invention disclosed by Russ et al (see page 11, paragraph 107 and page 15, paragraph 145).



As per claims 11-13, **Russ et al** substantially discloses the slave unit is adapted to transmit communications using secure such as SSL and TLS as well as non-secure communications which implies HTTP (protocols well known in the art) (see page 9, paragraphs 87-88). One of ordinary skill in the art would understand that HTTP is the protocol used for non-encrypted information.

4. **Claims 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2003/0219127 to **Russ et al** in view of US Patent 6,813,264 to **Vassilovski**.

As per claims 8-10, **Russ et al** substantially discloses wherein said agency communication section analyzes encrypted data, and executes the communications to a Web server or a slave unit in the intranet on the basis of the judgment result (see page 10, paragraph 92). **Russ et al** does not explicitly disclose judging whether the encrypted data indicates a Web access or encrypted private branch IP telephone communication, but suggests any type of communication protocol (see page 2, paragraph 24). **Vassilovski** in an analogous art teaches determining whether encrypted data should be routed to VOIP or PSTN and executes the communications to a Web server or a slave unit on the basis of the judgment result that meets the recitation of wherein said agency communication section analyzes the encrypted data to judge whether the encrypted data indicates a Web access or encrypted private branch IP telephone communication, and executes the communications to a Web server or a slave unit in the intranet on the basis of the judgment result (see abstract and figure 2). Therefore, Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify **Russ et al** to include judging for data such as web access or IP telephone communication and executes the communications to a Web server or a slave unit in the intranet on the basis of the judgment result because it would direct communications to the right service according to user registration and entitlement to the service as suggested by **Vassilovski** (see column 2, line 35 through column 3, line 23).

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the prior art discloses communications between devices protected by a firewall and devices located outside the firewall. (See PTO-form 892).

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5.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Colin/

Carl Colin

Patent Examiner, A.U. 2136

June 24, 2007